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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,003

09/13/2007

Ted Maddess

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7250

32116

7590

12/23/2008

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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SUITE 3800  
CHICAGO, IL 60661

EXAMINER

JANG, CHRISTIAN YONGKYUN

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,003	<b>Applicant(s)</b> MADDESS ET AL.	
	<b>Examiner</b> CHRISTIAN Y. JANG	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/26/06</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

2. The IDS submitted on May 26, 2006 has been considered in full by the examiner.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 12 recites a stimulator that presents optical patterns to the eyes, ears or skin of the subject. It would appear to not make sense to present optical patterns to the ears or skin.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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8. Claims 1-10 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). The method as claimed recite steps w/o the use of an apparatus tied into the claim language, and the steps fail to show any transformation of underlying subject matter as they simply recite the presentation of stimuli and the measurement of the response. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Maddess et al. (US 2003/0163060).

11. As to claim 1, Maddess teaches a method of assessing a sensory nervous system of a subject (Abs), including: simultaneously presenting two or more parts of the sensory system with respective sequences of stimuli ([0010]), varying each sequence

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over time between a null stimulus and one or more less frequent non-null stimuli ([0011]), controlling the variation of each sequence so that neighboring parts of the sensory system are less likely to receive simultaneous non-null stimuli ([0011]), measuring one or more simultaneous responses by the subject to the sequences of stimuli ([0012]), and determining weight functions from the response for assessment of the sensory system ([0012]).

12. As to claim 2, Maddess teaches the step wherein the non-null stimuli appear in each sequence at a rate of about 0.25 to 25 per second ([0028]).

13. As to claim 3, Maddess teaches the possibility of neighboring parts in the sensory system having simultaneous non-null stimuli is zero (Fig. 3; [0078]).

14. As to claim 4, Maddess teaches the sensory system is a visual system and multiple parts of the retina are presented with stimuli ([0003]).

15. As to claim 5, Maddess teaches the sensory system is a visual system and the sequences include either binocular or dichoptic stimuli ([0072]).

16. As to claim 6, Maddess teaches the sensory system is an aural or tactile system and the ears or skin are presented with stimuli ([0014]).

17. As to claim 7, Maddess teaches the parts of the sensory system are in the retina, the ears, the skin, or in the brain of the subject ([0014]; [0056]).

18. As to claim 8, Maddess teaches the stimuli are selected from a range of signals such as light or sound frequency, or pressure ([0014]; [0076]).

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19. As to claim 9, Maddess teaches the parts of the sensory system receiving stimuli form a region divided into classes and only one of the classes has a non-zero probability of receiving stimuli at any time ([0022], claim 1).

20. As to claim 10, Maddess teaches a method wherein the responses are nonlinear and the weight functions are Wiener or Volterra kernels (claim 21).

21. As to claim 11, Maddess teaches a stimulator ([0030]), a monitor ([0031]), and processor ([0032]), which provide the same functions as the method of claim 1.

22. As to claim 12, Maddess teaches the apparatus wherein the sensory system is a visual aural or tactile system and the stimulator presents optical patterns to the eyes, ears or skin of the subject ([0014]; [0056]; [0076]).

23. As to claim 13, Maddess teaches the monitor measures response to the stimuli by way of electrode potentials on the head of the subject ([0002]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN Y. JANG whose telephone number is (571)270-3820. The examiner can normally be reached on Mon. - Fri. (8AM-5PM) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/  
Supervisory Patent Examiner  
Art Unit 3735

CJ  
/C. Y. J./  
Examiner, Art Unit 3735  
12/17/08